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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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QUALCOMM INCORPORATED
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SAN DIEGO, CA 92121

EXAMINER

GOODCHILD, WILLIAM J

ART UNIT	PAPER NUMBER
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2109

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	03/13/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary

Application No.

10/649,552

Applicant(s)

MIR ET AL.

Examiner

William J. Goodchild

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 01/28/2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

1. This Office Action is in response to the Application filed 08/26/2003

Drawings

2. The drawings are objected to because:

Fig. 2 does not show item 218 as referenced to by the specification, paragraph 0017, line 3.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

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the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

3. Claims 1-9 are objected to because of the following informalities:

Claim 1, line 9, the phrase "IPCP configuration request" has been defined in claim 1, line 5, it is suggested to change the phrase to --the IPCP configuration request-- , in order to improve the clarity of the claim language.

Claim 6, line 13, the phrase "an IPCP configuration request" has been defined in claim 6, line 8, it is suggested to change the phrase to --the IPCP configuration request-- , in order to improve the clarity of the claim language.

Claim 7, line 2, the phrase "the same electronic device" should be changed to --an electronic device--, as this limitation has not been previously recited in the claim.

Claim 8, recites the limitation "The apparatus of Claim 7, wherein the at least one processing element is located in an electronic device that does not host the PPP client.". Claim 7 is limited "wherein the at least one processing element is located in an electronic device that hosts the PPP client". It is unclear how claim 8 can limit claim 7 further, as claim 7 requires the "processing element" to be located in an electronic device that hosts the PPP client, and claim 8 is removing the processing element from the electronic device that hosts the PPP client. For the purpose of examination, the examiner is assuming that claim 8 should be dependent on claim 6 rather than claim 7.

Claim 9, line 9, the phrase “an IPCP configuration request” has been defined in claim 9, line 5, it is suggested to change the phrase to –the IPCP configuration request-- , in order to improve the clarity of the claim language.

Appropriate correction is required.

Any claim not specifically addressed above, is being rejected as incorporating the deficiencies of a claim upon which it depends.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Independent claim 1 is drawn towards a method for extending a protocol synchronization period, comprising; generating a negative acknowledgment message and generating an acknowledgement message. In order for a method claim to be statutory, it must result in useful, concrete, and tangible results. In this instance there is no result of the method claimed; generating an acknowledgment message does not result in any real world change as it does not create a tangible result specifying any use of the generated acknowledgment.

Claims 2-5, which are dependent on claim 1 do not add any tangible results to the claim and thus are rejected for the same reason.

Independent claim 6 is drawn towards an apparatus for extending a protocol synchronization period, comprising; a memory element, a processing element, generating a negative acknowledgment message and generating an acknowledgement message. In order for an apparatus claim to be statutory, it must result in useful, concrete, and tangible results. In this instance there is no result of the method claimed; generating an acknowledgment message does not result in any real world change as it does not create a tangible result specifying any use of the generated acknowledgment.

In addition, claim 6 can be considered to be software in accordance with applicants specification, (page 8, Detailed Description, lines 1-7). In order for a claim to be statutory, it must fall within a process, machine, manufacture, or a composition of matter. Software does not fall within a statutory category since it is not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

Claims 7-8, which are dependent on claim 6 do not add any tangible results to the claim and thus are rejected for the same reason.

Independent claim 9 is drawn towards an apparatus for extending a protocol synchronization period, comprising; generating a negative acknowledgment message and generating an acknowledgement message. In order for an apparatus claim to be statutory, it must result in useful, concrete, and tangible results. In this instance there is no result of the method claimed; generating an acknowledgment message does not result in any real world change as it does not create a tangible result specifying any use of the generated acknowledgment.

In addition, claim 9 can be considered to be software in accordance with applicants specification, (page 8, Detailed Description, lines 1-7). In order for a claim to be statutory, it must fall within a process, machine, manufacture, or a composition of matter. Software does not fall within a statutory category since it is not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

Independent claim 10 is drawn towards a method for extending a protocol synchronization period, comprising; engaging the Point-to-Point Protocol client in an Internet Protocol Control Protocol negotiation and triggering the Point-to-Point Protocol client to generate configuration requests messages. In order for a method claim to be statutory, it must result in useful, concrete, and tangible results. In this instance there is no result of the method claimed; engaging the Point-to-Point Protocol client in an

Internet Protocol Control Protocol negotiation and triggering the Point-to-Point Protocol client to generate configuration requests messages does not result in any real world change as it does not create a tangible result specifying any use of the generated configuration request.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 1-6 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Liroy et al. (US Patent No. 6,483,822).

In reference to claim 1, Liroy et al. teaches a method comprising:

generating a negative acknowledgment message at the PPP server in response to an Internet Protocol Control Protocol (IPCP) configuration request from the PPP client, wherein the negative acknowledgement message includes deliberately arbitrary supplemental IPCP information and does not include an IP address option, (column 6, lines 34-38, column 7, lines 2-6, 30-39, column 5, lines 28-31 and 44-53, the negative acknowledgment message (NAK) contains hint values (values that would be accepted,

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based on request options) which will cause (column 7, line 33) the client to send another request, in this case, an IP address is not sent); and

generating an acknowledgement message at the PPP server in response to an PCP configuration request from the PPP client if the PPP server has received all required parameters to complete the protocol synchronization period, (column 6, lines 23-30 and 39-46, column 7, lines 30-39).

In reference to claim 2, Liroy et al. teaches the method of claim 1 wherein:

generating a new negative acknowledgment message at the PPP server in response to a repeated IPCP configuration request from the PPP client, wherein the new negative acknowledgement message includes different supplemental IPCP information from a previous negative acknowledgement message and does not include an IP address option, (column 6, lines 34-38, column 7, lines 2-6, 30-39, column 5, lines 28-31 and 44-53, the negative acknowledgment message (NAK) contains hint values which will cause (column 7, line 33) the client to send another request, in this case, an IP address is not sent, the hint values can change with each new NAK message, based on each new request being sent with new information).

In reference to claim 3, Liroy et al. teaches the method of claim 1 wherein:

generating a new negative acknowledgment message at the PPP server in response to a repeated IPCP configuration request from the PPP client, wherein the new negative acknowledgement message includes the same supplemental IPCP

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information as a previous negative acknowledgement message and does not include an IP address option, (column 6, lines 34-38, column 7, lines 2-6, 30-39, column 5, lines 28-31 and 44-53, the negative acknowledgment message (NAK) contains hint values which will cause (column 7, line 33) the client to send another request, in this case, an IP address is not sent, the hint values will not change with each new NAK message, based on each new request not sending new or different options).

In reference to claim 4, Liroy et al. teaches the method of claim 1 wherein:

the arbitrary supplemental IPCP information is an arbitrary Domain Naming System (DNS) address, (column 7, lines 2-6, 30-39, column 5, lines 28-31 and 44-53, the negative acknowledgment message (NAK) contains hint values (values that would be accepted, based on request options) which will cause (column 7, line 33) the client to send another request, by requesting a DNS address, an arbitrary one will be sent back as part of the supplemental IPCP information).

In reference to claim 5, Liroy et al. teaches the method of claim 1 wherein:

the arbitrary supplemental IPCP information is an arbitrary Windows Internet Naming Service (WINS) address, (column 7, lines 2-6, 30-39, column 5, lines 28-31 and 44-53, the negative acknowledgment message (NAK) contains hint values (values that would be accepted, based on request options) which will cause (column 7, line 33) the client to send another request, by requesting a WINS address, an arbitrary one will be sent back as part of the supplemental IPCP information).

In reference to claim 6, Liroy et al. teaches a apparatus comprising:

at least one memory element, (column 6, line 26, which indicates a network layer, which according to column 2, lines 48-50 involve computers, which have a memory); and

at least one processing element configured to execute a set of instructions stored in the at least one memory element, (column 6, line 26, which indicates a network layer, which according to column 2, lines 48-50 involve computers, which have a processor), the set of instructions for:

generating a negative acknowledgment message at the PPP server in response to an Internet Protocol Control Protocol (IPCP) configuration request from the PPP client, wherein the negative acknowledgement message includes deliberately arbitrary supplemental IPCP information and does not include an IP address option, (column 6, lines 34-38, column 7, lines 2-6, 30-39, column 5, lines 28-31 and 44-53, the negative acknowledgment message (NAK) contains hint values which will cause (column 7, line 33) the client to send another request, in this case, an IP address is not sent); and

generating an acknowledgement message at the PPP server in response to an IPCP configuration request from the PPP client if the PPP server has received all required parameters to complete the protocol synchronization period, (column 6, lines 23-30 and 39-46, column 7, lines 30-39).

In reference to claim 9, Liroy et al. teaches a apparatus comprising:

means for generating a negative acknowledgment message at the PPP server in response to an Internet Protocol Control Protocol (IPCP) configuration request from the PPP client, wherein the negative acknowledgement message includes deliberately arbitrary supplemental IPCP information and does not include an IP address option, (column 6, lines 34-38, column 7, lines 2-6, 30-39, column 5, lines 28-31 and 44-53, the negative acknowledgment message (NAK) contains hint values which will cause (column 7, line 33) the client to send another request, in this case, an IP address is not sent); and

means for generating an acknowledgement message at the PPP server in response to an IPCP configuration request from the PPP client if the PPP server has received all required parameters to complete the protocol synchronization period, (column 6, lines 23-30 and 39-46, column 7, lines 30-39).

7. Claim 10 is rejected under 35 U.S.C. 102(e) as being anticipated by Liroy et al. (WO 01/52499).

In reference to claim 10, Liroy et al. teaches a method comprising:

engaging the PPP client in an Internet Protocol Control Protocol (IPCP) negotiation, (page 7, line 30 – page 8, line 3, page 10, lines 6-9, page 11, lines 3-7, page 9, lines 17-19); and

triggering the PPP client to generate configuration request messages with deliberately arbitrary IPCP addresses, (page 9, lines 22-25 and lines 28-29).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being obvious over Liroy et al. (US Patent No. 6,483,822) in view of Liroy (WO 01/52499).

The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

In reference to claim 7, Lioy et al. (US Patent No. 6,483,822) teaches the apparatus as disclosed in claim 6.

Lioy et al. (US Patent No. 6,483,822) explicitly teaches the limitations as disclosed above except for the limitation of:

the at least one processing element is located in the same electronic device that hosts the PPP client.

The general concept of hosting multiple hardware components in the same device, is well known within the art as illustrated by Lioy (WO 01/52499) which discloses the use of hosting multiple hardware components in the same device, (Lioy (WO 01/52499, page 8, line 27 – page 9, line 4), and falls within the realm of common knowledge as obvious design optimization and configuration for the intended use of the item.

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Lioy et al. (US Patent No. 6,483,822) as taught by Lioy (WO 01/52499) in order to make use of the well known concept of hosting multiple hardware components in the same device as stated in claim 7.

In reference to claim 8, Lioy et al. (US Patent No. 6,483,822) teaches the apparatus as disclosed in claim 7.

Lioy et al. (US Patent No. 6,483,822) explicitly teaches the limitations as disclosed above except for the limitation of:

the at least one processing element is located in an electronic device that does not host the PPP client.

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The general concept of separating multiple hardware components, is well known within the art as illustrated by Lioy (WO 01/52499) which discloses the use of separating multiple hardware components, (Lioy (WO 01/52499, page 8, line 27 – page 9, line 4), and falls within the realm of common knowledge as obvious design optimization and configuration for the intended use of the items.

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Lioy et al. (US Patent No. 6,483,822) to include the use of separating multiple hardware components as taught by Lioy (WO 01/52499) in order to make use of the well known concept of separating multiple hardware components as stated in claim 8.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Goodchild whose telephone number is (571) 270-1589. The examiner can normally be reached on Monday - Friday / 8:30 AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frantz Jules can be reached on (571) 272-6681. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William J Goodchild
Examiner
Art Unit 2109

WJG
February 26, 2007

FRANTZ JULES
SUPERVISORY PATENT EXAMINER
